

09-14-06

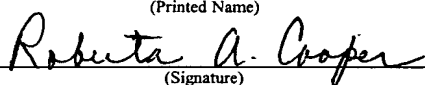
AP
JW



Atty. Dkt. No. 035451-0169 (3707.Palm)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant: Kammer, David
Title: DATA PRIORITIZATION
AND DISTRIBUTION
LIMITATION SYSTEM
AND METHOD
Appl. No.: 10/006,952
Filing Date: 11/5/2001
Examiner: Sams, Matthew C.
Art Unit: 2643
Confirmation No.: 2782

CERTIFICATE OF EXPRESS MAILING	
I hereby certify that this correspondence is being deposited with the United States Postal Service's "Express Mail Post Office To Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
EV 828706807 US	09/13/06
(Express Mail Label Number)	(Date of Deposit)
Roberta A. Cooper	
(Printed Name)	
	
(Signature)	

TRANSMITTAL

Mail Stop **APPEAL BRIEF - PATENTS**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

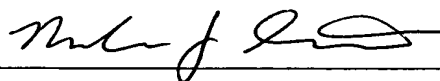
Sir:

Transmitted herewith is the following document for the above-identified application.

[X] Reply Brief Under 37 C.F.R. § 41.41 (6 pages).

Respectfully submitted,

Date 9/13/2006

By 

FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (414) 319-7306
Facsimile: (414) 297-4900

Matthew J. Swietlik
Attorney for Appellant
Registration No. 58,428

Application No. 10/006,952



Atty. Dkt. No. 035451-0169 (3707.Palm)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant: Kammer, David

Title: DATA PRIORITIZATION
AND DISTRIBUTION
LIMITATION SYSTEM
AND METHOD

Appl. No.: 10/006,952

Filing Date: 11/5/2001

Examiner: Sams, Matthew C.

Art Unit: 2643

Confirmation No.: 2782

CERTIFICATE OF EXPRESS MAILING	
I hereby certify that this correspondence is being deposited with the United States Postal Service's "Express Mail Post Office To Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
EV 828706807 US	09/13/06
(Express Mail Label Number)	(Date of Deposit)
Roberta A. Cooper	
(Printed Name)	
	
(Signature)	

REPLY BRIEF

Mail Stop **APPEAL BRIEF - PATENTS**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Under the provisions of 37 C.F.R. § 41.41, this Reply Brief is being filed in response to the Examiner's Answer dated July 14, 2006. The Appeal Brief was filed May 1, 2006, in response to a Final Action dated December 1, 2005.

REMARKS

The Examiner's Answer included the following response to Appellant's arguments in section 7(III)(B) of Appellant's Appeal brief:

The Appellant is arguing that Hendrey, viewed as a whole, teaches that a separate matchmaker creates a list in response to user initiation, but does not provide it to the user for display. However, in Col. 12 lines 52-56, Hendrey clearly teaches that the matchmaker could be automated (and separate as Appellant argues) but alternatively also explicitly recites that the matchmaker could "be partially or entirely a person using a telecommunication device and having access to distance information." The Examiner considers that in order for a user to perform the functions of selecting users from a filtered list and calling each user on the list that the list must be logically be displayed on a display to the matchmaking user.

The Appellants further argue that, in Hendrey, group members within a maximum distance are selected (into a list) but the list is not sorted based on distance values. However, in Col. 10 lines 1-6, Hendrey explicitly recites that the list "may be sorted by proximate distance". Therefore, when viewed as a whole, Hendrey clearly provides the claimed teachings.

Further, the Examiner notes that a step of "sorting" is not claimed, only that the list be sorted by distance or direction. . . . In the example shown in Hendrey;s Fig. 2, a list with two entries, the Examiner submits that regardless of the two values "Dist. #1" and "Dist. #2", with only two entries, the list is sorted greatest to lowest or lowest to greatest and therefore, clearly meets the broadly claimed "sorted" limitation.

Appellant respectfully disagrees, and submits that the Examiner has still failed to establish that Bork et al. in view of Hendrey et al. teaches all of the limitations of the rejected claims. Specifically, no combination of Bork et al. and Hendrey et al. teaches displaying a sorted list to a user of a handheld or wireless communication device, as claimed in independent claims 1, 8, 16, and 24. For example, independent claim 24 recites a "user interface for a handheld computer" having "a display providing a list of indicators . . . sorted by at least one of distance and direction from the handheld computer . . configured to allow a user to select one of the indicators so that the user can share information." Appellant points out that Hendrey et al. teaches that the matchmaking functions are carried out by a separate entity (107) (whether automated or not) than the mobile user's device (101) (see, for example, FIG. 1 of Hendrey et al. and col. 9, lines 54-56 "the initiator's MU 101a transmits a request

for matchmaking via a wireless link . . . to matchmaker 107”). Even the Examiner’s statement that “in order for a user to perform functions of selecting users from a filtered list and calling each user on the list[,] the list must be logically displayed on a display to the matchmaking user” (emphasis added) implies that any display that may be provided by a matchmaker is displayed “to the matchmaking user,” and not the user of the wireless device. Thus, even if the matchmaker displays a list of potential callees, the list is not displayed to the mobile user such that the mobile user may make selections from the list, as in the subject matter claimed in the present application.

Appellants further point out, in response to the Examiner’s statements regarding the “sorted” limitation, that even accepting the Examiner’s narrow interpretation of the claim language, the combination of Bork et al. in view of Hendrey et al. still fails to teach or suggest displaying the sorted list to a user of the wireless device such that the user may make a selection from the list. Hendrey et al. does not teach that the information shown in FIG. 2 is displayed to a user, but only that a computer system 210 has access to the group list information shown in FIG. 2. Hendrey et al. teaches only that a user of the wireless device may select and activate a group list.

Accordingly, Appellant submits that the Examiner has failed to establish a prima facie case of obviousness with respect to independent claims 1, 8, 16, and 24, and their respective dependent claims, because the combination of Bork et al. in view of Hendrey et al. fails to teach or suggest at least one limitation of each of the rejected claims.

The Examiner’s Answer further included the following response to Appellant’s arguments in section 7(III)(B) of Appellant’s Appeal Brief:

With respect to the Appellant’s argument that there is no suggestion to combine the references (Pages 13-14), the Examiner recognizes that obviousness can only be established by combining or modifying teachings of the prior art to produce the claimed invention when there is some teaching, suggestion, or motivation to do so found in either the references themselves or in knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992).

In this case, it is the Examiner's opinion that the Appellant is not viewing Hendrey as a whole. For instance, Hendrey specifically teaches the use of global positioning systems, time difference of arrival, and angle of arrival for determining the location of telecommunication users. (Col. 5 lines 26-41). Hendrey teaches, "notions of distance are in particular intended to encompass not only literal distance measure, but additionally any and all measures conducive to identifying a set of users who would have the least difficult separation to overcome in order to attend a physical group meeting". (Col. 8 lines 56-67) The teachings of Hendrey coincide with the teachings of Bork in that not only physical distance between mobile devices is taken into account but also the path of least resistance when determining a place for a physical group meeting between mobile users. (Bork Fig. 2, Col. 4 line 54 through Col. 5 line 67, and Hendrey Col. 8 lines 56-67).

Therefore, when viewing the combination of Bork in view of Hendrey as a whole, the teachings lead the Examiner to a mobile device that allows for searching, sorting and connecting users located proximately to each other, taking into account the distance, direction and path of least resistance between the mobile devices. (Bork Fig. 2, Col. 4 line 54 through Col. 5 line 67, Hendrey Col. 6 line 1 through Col. 7 line 3, Col. 8 lines 56-67, Col. 9 lines 45-53[,] Col. 10 lines 1-39 and Col. 12 lines 38-56).

Appellant does not disagree with the Examiner that Hendrey et al. involves "notions of distance." However, Appellant respectfully disagrees with the Examiner's reasoning and conclusion, and submits that the Examiner has not overcome the fact that modifying the teachings of Bork et al. with the teachings of Hendrey et al., in attempting to arrive at the subject matter of the rejected claims, would change the principal of operation of Bork et al., which is improper in establishing a prima facie case of obviousness.

Bork et al. is titled "Wireless Location and Direction Indicator for Multiple Devices" and is directed toward a system and method for providing distance and direction information to a user of a wireless device. Bork et al. states at col. 7 lines 4-6 that "[t]he graphic display 114 is preferably capable of supporting a clear arrow indicating the target direction, as well as its estimated distance." Bork et al. additionally states that alternative means of indicating distance and direction, such as audible or touch sensitive devices, may also be used. See col. 6, lines 39-44. Thus, Bork et al. is clearly primarily concerned with providing specific distance and direction information to a user.

Referring to Hendrey et al., however, connections are initiated between two or more mobile telecommunications users based on predefined criteria without providing specific distance or direction information to the user. See col. 5, lines 21-25. For example, a user may elect to initiate a call with a maximum number of callees within a predefined maximum distance of the user. See col. 7, lines 9-12. Upon receiving the callee selection criteria, the communications unit simply initiates connections with the users satisfying the predefined criteria. The user does not select callees from a list, and the user is not provided with specific distance and/or direction information for any of the callees. The user merely provides the predefined criteria used to identify callees with whom a connection is then automatically initiated. As discussed above, even if a sorted list is generated in Hendrey et al. by a “matchmaker,” this information is used only by the matchmaker (whether automated or not) as a separate entity, and Hendrey et al. teaches that this information is not provided to a user of the wireless device. This is a substantial change in operation from the system of Bork et al., where specific distance and direction information is provided to a user of the wireless device. Applying the concepts of Hendrey et al. to the device in Bork et al. would eliminate displaying the desired direction and distance information in Bork et al. Therefore, because the proposed combination of Bork et al. and Hendrey et al. would change the principal of operation of Bork et al., there is no suggestion to combine the references.

With respect to the Examiner’s comment that “the teachings of Hendrey coincide with the teachings of Bork in that not only physical distance between mobile devices is taken into account but also the path of least resistance when determining a place for a physical group meeting between mobile users,” Appellant respectfully submits that the fact that both of the cited references may involve distances between users of mobile communications devices does not overcome the fact that, considering the teachings of Hendrey et al. as a whole, including the teachings in Hendrey et al. that a user does not select callees from a list, and the user is not provided with specific distance and/or direction information for any of the callees, to modify Bork et al. using the teachings of Hendrey et al. would change the principal of operation of Bork et al.

Therefore, it is respectfully submitted that the Examiner has failed to establish a prima facie case of obviousness because there is no suggestion to combine the teachings of Bork et

al. and Hendrey et al. Accordingly, the rejection of claims 1-5, 8-13, 15-19, and 23-29 should be reversed.

CONCLUSION

In view of the foregoing, as well as in view of the Argument set forth in Appellant's Appeal Brief, Appellant respectfully requests that the Board reverse all claim rejections and indicate that a notice of allowance respecting all pending claims should be issued.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447.

Should no proper payment be enclosed herewith, as by a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is hereby authorized to charge the unpaid amount to Deposit Account No. 06-1447.

Respectfully submitted,

Date 9/13/2006

By 

FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (414) 319-7306
Facsimile: (414) 297-4900

Matthew J. Swietlik
Attorney for Appellant
Registration No. 58,428